

09/522,085
Art Unit 3624
9137.00

Claim 1

Claim 1 recites **identifying** an ATM having stated characteristics:

- 1) a screen for displaying options for withdrawing cash and
- 2) a touch input mechanism for receiving user commands.

Plainly, that ATM is a **pre-existing** entity, and is not being manufactured at the time of identification.

After identification, claim 1 states that the ATM is modified in a particular way.

The Suer reference does not (1) identify an existing ATM and then (2) modify it as recited. Suer **DOES** state that a user can "withdraw money" from his ATM using "device 10," which resembles a Personal Digital Assistant, PDA. (Column 6, lines 54 - 56; Suer's Figures 2A - 2E illustrate the device.) However, that only shows an ATM having the characteristic of performing money withdrawals using a PDA.

Therefore, the steps of (1) identifying an ATM and (2) modifying the ATM, as recited in claim 1, are not shown in Suer. This conclusion is true notwithstanding the Office Action's assertions (eg, bottom of page 2) that Suer does show the claim recitations. The undersigned attorney has examined the cited passages of Suer, and none of them show the claim recitations, nor

09/522,085
Art Unit 3624
9137.00

anything close.

In connection with the issue of "identifying" an ATM and then "modifying" it, on or about September 17, 2003, the undersigned attorney downloaded the Suer reference from the PTO's web site, and searched for the terms "modif." No results were obtained.

Then a search for "ident" and "locat" was made. The following results were obtained:

column 2, line 19, which states that a user must "identify himself";

column 6, line 50, and column 11, line 43, both of which refer to a "personal identification number (PIN);

column 13, line 24, 25, both of which refer to a "unique identification" which the PDA uses to identify itself;

column 14, line 8, which refers to identifying a data packet;

column 14, line 14, which refers to an "identical data packet;"

column 15, line 45, which refers to identification of an "information storage device" from which data was received; and

column 18, line 48, which refers to a "merchant's location."

Therefore, since words such as "modify," "modification," and "identify," appear to be absent from Suer, Applicant requests the PTO to explain how Suer shows identification of the ATM (or SST) as claimed. That is, for example, none of the passages in Suer

09/522,085
Art Unit 3624
9137.00

using a word containing "ident" have any relevance to identification of an ATM, as claimed.

In addition, the undersigned attorney searched Suer for the following terms: "phone," "telephone," "cell," and "wireless." The search indicated that those character strings are not present in Suer (at least not in the text). The undersigned attorney examined the Figures in Suer, and can find nothing resembling a telephone or cell phone.

Claim 1 recites

. . . modifying said ATM to enable it to receive from a **wireless telephone** user commands for dispensing cash.

No "wireless telephone" appears to be present in Suer.

Therefore, the following three elements are absent from Suer:

- 1) identification of an ATM having the claimed characteristics;
- 2) modifying that ATM;
- 3) to thereby allow a wireless telephone to perform certain functions.

Claim 22

Claim 22 states that the ATM identified lacks certain characteristics. The Office Action, page 3, bottom, cites several passages in Suer as showing this recitation. The undersigned

09/522,085
Art Unit 3624
9137.00

attorney has examined them, and cannot find the recited ATM.

Applicant points out that the Office Action is making self-contradictory assertions. The Office Action identifies an ATM which supposedly corresponds to that of claim 22. The only ATM which the undersigned attorney can find in Suer is ATM 20 in Suer's Figure 1.

If that ATM corresponds to the ATM in claim 22, then that ATM must be "incapable of receiving user commands for dispensing cash from a wireless telephone," because of the language of claim 22. That lack of capability may very well exist in Suer: Suer does not show a "wireless telephone." Thus, his ATM may possess the recited lack of capability.

If so, where is the ATM of claim 1, which communicates with the "wireless telephone" ? That is, two ATMs are recited: (1) the initial, "identified" ATM, and (2) the "modified" ATM. The ATM of claim 22, if found in Suer, cannot qualify as both. Two ATMs must be shown

From another perspective:

- 1) No discussion of a modification of an existing ATM appears to be present in Suer.
- 2) Suer does not show a wireless telephone. So why would he discuss the modification in question (which allows a wireless telephone to interact with an ATM) ?
- 3) Suer uses something different. It appears that Suer's PDA interacts with the ATM using

09/522,085
Art Unit 3624
9137.00

direct wireless communication. (Column 10, bottom.) That is, it appears that Suer does not utilize the common-carrier cellular telephone system. Rather, his PDA must be adjacent an ATM, Point of Sale Terminal (POS), kiosk, etc. (Column 12, lines 30 - 40.)

This conclusion is consistent with Suer's discussion of IrDA (column 14, line 25) and an IR transceiver (column 9, line 34.) Both refer to short-range communication, using infra-red radiation.

Thus, Suer does not use a wireless telephone, nor even the wireless telephone network (eg, a cellular network.) Suer uses short-range infra-red communication, which is completely different.

The preceding applies to claims 8, 15, 20, 21, and 26 - 29. In addition, the the "upgrading" of claim 21 has not been shown.

Claims 2 - 5 are considered patentable, based on their parents.

Claims 6 and 7

Claims 6 and 7 state that the ATM is connected to a network. The Office Action cites Suer, column 13, line 17 - column 14, line 17, in support of this. (A typographical error seems to appear on page 3, line 7 of the Office Action: the "1" in "14" appears to be missing.)

However, that location does not seem to discuss a network. Nevertheless, it is well known that ATM's are, in fact, connected to financial networks, such as "Cirrus."

09/522,085
Art Unit 3624
9137.00

Claims 6 and 7 state that the "wireless telephone" is connected to the network. The undersigned attorney submits that the prior art inherently **teaches against** such a connection (of letting a wireless telephone connect to the financial network.) Such a connection would allow hackers to gain access to the banking system, and that would never be allowed.

In further support of this point, the undersigned attorney points out that, even though ATMs are connected to the financial network, it is a closed network. That is, it is physically impossible for a person, for example, to use the Internet to reach anything like an equivalent of a given ATM's web page. The reason is that the software and hardware which make up the network do not allow outsiders to reach the ATM.

Applicant offers to submit an affidavit on this point, namely, that operators of wireless telephones, and the public in general, are strictly prohibited from gaining access to the ATM networks.

In contrast. The "network" which supports the recitation of claims 6 and 7 is the ordinary Internet. The wireless telephone can gain access to the Internet, and thereby gain access to electronic banking. But that does not involve the financial network used by ATMs.

Therefore,

-- The implied network in Suer, namely, the financial network used by ATMs would never

09/522,085
Art Unit 3624
9137.00

allow access to an individual using a wireless telephone. Thus, the network access recited is absent from Suer.

-- One network of the Specification, which supports claims 6 and 7, is the Internet. That is not shown in Suer.

Once again: the ATM network shown in Suer does not allow the access recited in claims 6 and 7. The Internet, which is one example of a network possible in claims 6 and 7, is not shown in Suer.

Claims 16 - 19

Claim 16

Claim 16 recites:

16. A transceiver for installing in a self-service terminal (SST) during a retrofit operation of the SST, where the transceiver is operable to conduct wireless communication with a user of the SST, and the transceiver is adapted to convey transactions to the SST, so that when the transceiver is installed in the SST a user can execute a transaction on the SST using a wireless communication device.

Claim 16 recites the function of allowing "a user [to] execute a transaction on the SST using a wireless communication device." That function may be present in Suer.

However, the presence of that function does not imply that a

09/522,085
Art Unit 3624
9137.00

"transceiver" of the type recited in claim 16 is present. Claim 16 must be interpreted as reciting (1) an SST which is operable without the presence of the transceiver and (2) the transceiver as a discrete unit.

Those two elements have not been shown in Suer. One reason is that, unless the SST is functional prior to installation of any transceiver, no actual SST is present, as claimed. That is, an SST undergoing initial assembly at a manufacturing plant, wherein the functionality discussed above is being created, is not an SST as in claim 16. It is not functional, until assembled. But, at that time, there is no later installation of the "transceiver."

From another perspective, the fact that the function identified above may be present in Suer does not indicate that a separate "transceiver" exists.

A very fine distinction should be observed. Suer states, column 4, lines 30 - 42, that an infra-red transceiver can be installed onto one of his ports. However, claim 16 states:

. . . so that when the transceiver is installed in the SST a user can execute a transaction on the SST using a wireless communication device.

Suer's IR transceiver does not possess that characteristic.

That is, the **mere installation** of Suer's IR transceiver does not allow a user to execute the claimed transaction.

09/522,085
Art Unit 3624
9137.00

Claims 17 - 19

These claims recite a retrofitting step wherein a terminal is equipped with new functions, which did not exist previously. That has not been shown in Suer.

Claim 23

The response to claims 17 - 19 applies to claim 23

Claim 24

Claim 24 recites:

24. Apparatus according to claim 16, wherein the transceiver is connectable to a system bus of a computer within the SST.

The Office Action relies on Suer, column 4, lines 30 - 42, to show claim 24.

That location states that the IR adapter is connected to "the terminal unit's serial, parallel, Universal Serial Bus (USB) or IrDA port." None of those elements qualify as the "system bus."

It is well known that the "system bus" contains two elements:

- 1) the data lines, which run from memory to the microprocessor, and perhaps between other elements, and
- 2) the address lines, which also run between

09/522,085
Art Unit 3624
9137.00

memory (actually, a memory controller) and the microprocessor.

It may also contain control lines.

For example, when the microprocessor wants to read data from memory, it would place the address of the data onto the address lines, or address bus. It may then pull a control line, indicating a request for data.

A memory controller receives the address, locates the data at that address, and places the data onto the data bus. The controller may pull a control line, indicating that the data is ready. (This can be necessary to force the microprocessor to wait until the data stabilizes before attempting to read the data.)

This type of "system bus" is a completely different entity from the ports mentioned in Suer, column 4, lines 30 - 42. One reason is that, in general, a computer can exist, and perform computation, without those ports. For example, a word processor operating on a PC can operate with no trouble at all without serial ports or parallel ports. Printing on a printer may not be possible, but that can be remedied by copying the document to a diskette, and printing elsewhere.

However, if a "system bus" were absent, the PC could not operate at all.

Restated, the "system bus" is a necessary part of the computer, and is necessary for the microprocessor to operate. That

09/522,085
Art Unit 3624
9137.00

is not so with Suer's ports.

They do not correspond to the recited "system bus."

Claim 25

Claim 25 recites:

25. Apparatus according to claim 24, wherein the transceiver is assigned a telephone number, and the SST displays that telephone number to customers.

The Office Action has not asserted that this recitation is contained in Suer, nor identified a passage in Suer containing this recitation. Thus, the rejection should be withdrawn.

Added Claims 30 and 31

Added claim 30 states that the transceiver comprises an adapter card. That is plainly not present in Suer.

Claim 31 is added to preclude reading of claim 16 onto an apparatus which is undergoing initial assembly at a manufacturing plant.


09/522,085
Art Unit 3624
9137.00

Conclusion

Applicant requests that the rejections to the claims be reconsidered and withdrawn.

Applicant expresses thanks to the Examiner for the careful consideration given to this case.

Respectfully submitted,


Gregory A. Welte
Reg. No. 30,434

NCR Corporation
1700 South Patterson Blvd.
WHQ - 5
Dayton, OH 45479
September 17, 2003
(937) 445 - 4956
ATTACHMENT: Claims currently pending

WELTE DIRECT: (765) 296 - 4699

09/522,085
Art Unit 3624
9137.00

1. (Original) A method comprising: identifying an ATM which has a screen for displaying options for withdrawing cash and a touch input mechanism for receiving user commands; and modifying said ATM to enable it to receive from a wireless telephone user commands for dispensing cash.

2. (Original) The method of claim 1 wherein said modifying step includes retrofitting said ATM with a program for enabling said ATM to receive a transaction from a remote source.

3. (Original) The method of claim 1 wherein said modifying step includes retrofitting said ATM with a transceiver adapted to receive signals directly from the wireless telephone.

4. (Original) The method of claim 3, wherein said transceiver is further adapted to transmit signals directly to said wireless telephone.

5. (Original) The method of claim 4 wherein said signals implement local wireless communication.

6. (Original) The method of claim 1 wherein said ATM is

09/522,085
Art Unit 3624
9137.00

connected to a network for communication therebetween, and wherein said modifying step includes providing a connection between said network and said wireless telephone.

7. (Original) The method of claim 1 wherein said ATM is connected to a network for communication therebetween, and wherein said modifying step includes: retrofitting said ATM with a transceiver adapted to receive signals directly from a wireless telephone; and providing a connection between said network and said wireless telephone.

8. (Original) A method comprising: identifying an ATM which has a screen for displaying options for withdrawing cash and a touch input mechanism for receiving user commands; and modifying said ATM to enable it to receive from a wireless telephone user commands for dispensing cash without the use of said touch input mechanism.

9. (Cancelled) An ATM comprising: a touch input mechanism for receiving user commands; and a transceiver for receiving user commands from a wireless telephone; wherein said ATM is adapted to receive user commands for dispensing cash from each of said touch input mechanism, said wireless telephone, and both.

09/522,085
Art Unit 3624
9137.00

10. (Cancelled) A method for operating an ATM having a touch input mechanism for receiving user commands, the method comprising the step of dispensing cash from said ATM in response to user commands from a wireless telephone.

11. (Cancelled) The method of claim 10 wherein said dispensing step occurs without the receipt of user commands from said touch input mechanism.

12. (Cancelled) The method of claim 10 further comprising: dispensing said cash from said ATM; and charging a service fee for dispensing said cash to the account of the owner of said telephone.

13. (Cancelled) A method of operating an ATM having a touch input mechanism for receiving user commands comprising: placing a call from a wireless telephone to said ATM over a wide area communications network; and transmitting information from said wireless telephone to said ATM using both said wireless telephone and said touch input mechanism.

14. (Cancelled) The method of claim 13 further comprising: dispensing cash from said ATM; and charging a service fee for dispensing said cash to the account of the owner of said telephone.

09/522,085
Art Unit 3624
9137.00

15. (Original) A method comprising the steps of: identifying a self-service terminal (SST) which has a screen for displaying user options and a touch input mechanism for receiving user commands; and modifying the SST so that it receives user commands from a wireless telephone.

16. (Original) A transceiver for installing in a self-service terminal (SST) during a retrofit operation of the SST, where the transceiver is operable to conduct wireless communication with a user of the SST, and the transceiver is adapted to convey transactions to the SST, so that when the transceiver is installed in the SST a user can execute a transaction on the SST using a wireless communication device.

17. (Previously amended) A self-service terminal having been retrofitted to allow the terminal to execute transactions entered using a wireless telephone, wherein said terminal did not allow transactions to be entered using a wireless telephone prior to retrofitting.

18. (Previously amended) A self-service terminal having been retrofitted to receive a transaction from an authorized source external to the terminal, wherein said terminal was unable to receive transactions from said authorized source prior to

09/522,085
Art Unit 3624
9137.00

retrofitting.

19. (Previously amended) A self-service terminal including a program storage device, the device having been upgraded to encode a program of instructions for monitoring an external source and for receiving a transaction from an authorized source via the external source, wherein the terminal was unable to receive transactions via the external source prior to upgrading.

20. (Original) A method comprising: identifying a system which includes a host and a plurality of ATMs interconnected by a network in which each ATM has a screen for displaying options for withdrawing cash and a touch input mechanism for receiving user commands; and modifying said system to enable at least one of said ATMs to receive from a wireless telephone user commands for dispensing cash.

21. (Original) The method of claim 20 wherein said modifying step includes upgrading a program residing on said host, on at least one of said ATMs, or both.

22. (Previously added) Method according to claim 1, wherein, prior to the process of modifying said ATM, said ATM was incapable of receiving user commands for dispensing cash from a wireless

09/522,085
Art Unit 3624
9137.00

telephone.

23. (Previously added) Method according to claim 20, wherein, prior to modifying, no ATMs could receive user commands for dispensing cash from a wireless telephone.

24. (Previously added) Apparatus according to claim 16, wherein the transceiver is connectable to a system bus of a computer within the SST.

25. (Previously added) Apparatus according to claim 24, wherein the transceiver is assigned a telephone number, and the SST displays that telephone number to customers.

26. (Previously added) Method according to claim 15, wherein the SST was unable to receive user commands from a wireless telephone prior to the modifying process.

27. (Previously added) Method according to claim 7, wherein said ATM was unable to receive signals directly from a wireless telephone prior to the modifying step.

28. (Previously added) Method according to claim 8, wherein said ATM was unable to receive signals directly from a wireless

09/522,085
Art Unit 3624
9137.00

telephone prior to the modifying step.

29. (Previously added) Method according to claim 6, wherein communication between the wireless telephone and the ATM occurs through the network.

30. (New) Apparatus according to claim 16, wherein the transceiver comprises an adapter card installable in a computer.

31. (New) Apparatus according to claim 16, wherein the SSTs executed transactions prior to installation of the transceiver.